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MICHAEL RODAK, JR., CLERK

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1976

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No. 76-1575

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CONTROL DATA CORPORATION, *Petitioner,*

v.

TECHNITROL, INC., *Respondent.*

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**PETITIONER'S REPLY TO THE RESPONDENT'S  
BRIEF IN OPPOSITION TO PETITION FOR  
WRIT OF CERTIORARI TO THE COURT OF  
APPEALS FOR THE FOURTH CIRCUIT**

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Petitioner Control Data Corporation serves and files this reply to the "Brief In Opposition To Petition For Writ Of Certiorari To The Court Of Appeals For The Fourth Circuit" (hereafter, the "Opposition") due to the appearance of unexpected and erroneous assertions in it.

**CHANGES IN CLAIM CONSTRUCTION DID OCCUR**

First is the matter of the construction that Respondent has placed upon its claims. We are extremely surprised that Respondent would assert that it had *always* construed claim 19 to be limited to the "Reset Feature". Respondent cites no instance of it ever having

so informed Petitioner before it became apparent from the Court of Claims proceedings, and we know of none. The opposite is the case, as correctly stated in the Petition.

Early on in this matter, in contacts between the parties before the litigation was launched, the patentee (now Respondent) asserted the patent in suit, *inter alia*, against Petitioner's so-called tape transport equipment. As stated in the Petition, p. 6, these were and are magnetic storage systems which are inherently not position volatile and do not need or have the reset feature. In passing, we draw attention to the fact that in the Opposition Respondent does not deny these aspects of tape transport equipment, or that it had earlier accused them.

It could never have been claim 16 of the patent in suit that was urged against tape transports, because that claim calls for "~~—continuous relative rotation between said magnetic storage member and said magnetic recording and recording device—~~". Tape transports do not have continuous relative rotation. Instead, the tape is simply passed back and forth between two reels. Therefore, the assertion against tape transports was based on other claims, and claims 6 and 9 were usually pointed to as broad and exemplary. Those claims use essentially the same language to recite the register selection function, i.e., the "~~—voltage combinations representative respectively of said registers—~~". We set forth claims 6, 9 and 19 on a fold-out attached inside the rear cover hereof to demonstrate the similarity of the recitals. Given the correspondence of claims 6, 9 and 19 in the register selection recitals, there was no way for anyone to know that claim 19 would be argued to be limited to a reset feature when

claims 6 and 9 were not so construed by the patentee.

There did come a time before suit when Petitioner thought it had persuaded Respondent that tape transports were not covered (because no voltage combinations successively occur in tape transports) but in early discovery steps the Respondent called for information on Petitioner's products, and included many requests pertaining to tape transports. This is in Exhibit A of a paper entitled "Notice Of Designations Of EDP Equipment Pursuant To Step (c) Of The Pretrial Order Of April 24, 1967", served August 2, 1967. Fifty-eight different entries directed to tape transports are included.<sup>1</sup>

For the reasons above given it is not correct for Respondent to argue that it had always asserted that claim 19 included the automatic memory reset feature. Instead, the situation is exactly as described in the Petition—the Respondent only changed its construction of the claims in its attempt to overcome the license problem presented to it in the Court of Claims.

Moreover, even if Respondent had always asserted the reset feature to be a limitation in the claims, the legal point would remain exactly the same. That is, that the claims are invalid because they do not particularly point out and distinctly claim the reset feature. The fact that Respondent changed its claim construction simply emphasizes the need for this Court to review the case and reverse the Court below.

<sup>1</sup> The Clerk of the Court of Appeals for the Fourth Circuit, upon request at the filing of the Petition, declined to forward the record of this case to this Court, but is understood to be willing to do so immediately upon request by this Court.



### THE ADAMS CASE DOES NOT CONTROL THIS CASE

The remaining arguments in the Opposition are adequately anticipated and discussed in the Petition, except that perhaps some comment on the *Adams* case<sup>2</sup> will be helpful to this Court. In the Opposition at pages 8 and 9 Respondent argues that *Adams* is authority by this Court for omitting recitation of features of an invention from patent claims. We respectfully submit that such is not at all the import of *Adams*.

In *Adams* the patent, No. 2,322,210<sup>3</sup> was in its entirety based on the use of an electrolyte in an electric battery to cooperate with the electrodes. Utter inoperability would have resulted without an electrolyte. Therefore, this Court held that the water prominently mentioned several places in the specification was to be understood in claims 1 and 10. In the present case, on the contrary, the reset feature is not necessary to the operation of the claimed system (see Petition, pages 8 and 9), and it cannot be imputed to the claims under the *Adams* decision. As this Court noted in *Adams*, at 383 U.S. 48, 49, water was "—a stated object of the invention—".<sup>4</sup> In the patent here in suit (Sharpless 2,611,813, see at Appendix to Petition, pp. 60-77) the stated objects of the patent, column 1, lines 12-34 (Ap-

<sup>2</sup> *United States v. Adams*, 383 U.S. 39 (1966).

<sup>3</sup> This patent would appear in the Appendix to the *Adams* Petition in this Court.

<sup>4</sup> See Patent 2,322,210 at page 1, left column, lines 9-14, "Another object is to provide a battery which is relatively light in weight with respect to capacity and in which the battery may be manufactured and distributed to the trade in a dry condition and rendered serviceable by merely filling the container with water."

pendix p. 67) do not include reference to any reset feature.

### CONCLUSION

The Petition should be granted and upon further proceedings the Court below should be reversed and the decision of the District Court reinstated.

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**Certificate of Service**

Three copies of the foregoing Reply have been served under Rule 33 of this Court upon Mr. S. C. Yuter and Mr. Paul V. Niemeyer, attorneys for Respondent Technitrol, Inc. by depositing same in a United States mail box, first class mail addressed to their post office addresses of record.

**ALLEN KIRKPATRICK, III**  
*Attorney for Petitioner*

**Claim 9.**

**"In an information storage system,**

**1. movable recording means including a plurality of registers for temporarily storing numerical information,**

**2. means for producing *different register-selection voltage combinations representative respectively of said registers and occurring successively* in timed relation to said movable recording means,**

**3. and means under control of an operator for selecting any one of said registers through the agency of said voltage combinations." \***

**Claim 6.**

**"In an information storage system,**

**1. movable recording means including a plurality of registers adapted to receive and store temporarily numerical information,**

**2. means for producing *different register-selection voltage combinations representative respectively of said registers and occurring successively* in timed relation with said movable recording means,**

**3. means under control of an operator at a remote position for producing a group of pulses indicative of a particular register and also containing numerical information which it is desired to store in that register,**

**4. means responsive to some of said pulses for producing a pattern of voltages,**

**5. means responsive coincidently to said voltage combinations and said voltage pattern for selecting said register,**

**6. and means for temporarily storing said numerical information in said register." \***

\* Emphasis and clause numbering is added in each claim.

**Claim 19.**

**"In an information storage system,**

**1. magnetic recording means having a plurality of information recording sections constituting registers and also having a register-selection section on which are recorded pulses coordinated with said registers,**

**2. means for producing from said recorded pulses *different successively-occurring register-selection voltage combinations representative respectively of said registers,***

**3. means under control of an operator at a remote position for producing a group of pulses indicative of a particular register and also containing numerical information which it is desired to store in that register,**

**4. means responsive to some of said pulses for producing a pattern of voltages,**

**5. means responsive coincidently to said voltage combinations and said voltage pattern for selecting said register,**

**6. and means for storing said numerical information in said register." \***